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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,708	09/21/1999	MICHAEL L. GOUGH	NEO1P018.US01	3709
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TIPS GROUP c/o Intellevate LLC P. O. BOX 52050 Minneapolis, MN 55402			EXAMINER VU, THONG H	
			ART UNIT 2419	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/400,708

Applicant(s)

GOUGH, MICHAEL L.

Examiner

Thong H. Vu

Art Unit

2419

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-3,5-8,11-22 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3,5-8,11-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. Claims 16-18 are reject under U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recites a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John Love, title 'Clarification of Process under 35 U.S.C. 101'). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 112

4. Claims 15-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

i.e.: The computer readable medium is not existed in specification.

Claim Rejections - 35 USC § 103

Claims 1-2,5-8,11-13,15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al [Horvitz 6,161,130] in view of Douglas [6,684,332 B1].

5. Claim 1, Horvitz discloses A method for executing an application program associated with an electronic message, comprising:

initializing at least one application program by automatically retrieving code (i.e.: applet) from a server over a network after an electronic message received over the network is opened for viewing by a user [Horvitz, execute client email program or application program, download from an email server, a preview mode is selected, open this message, col 7 lines 40-col 8 line 6],

wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message [Horvitz, displayed in some abbreviated manner or at least in part, col 7 lines 40-col 8 line 6], and

automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof [Horvitz, automatic execution of a software or application program, applet, col 21 lines 21-58];

An official Notice is taken that Java software is designed to allow computers to interactively and dynamically download computer program code fragments (called applets) over an electronic network such as Internet and execute the downloaded code locally [see Shear reference, col 2 lines 27-45].

However, Horvitz does not explicitly detail wherein the application program becomes associated with a context of the electronic message after being sent but before being received by the user;

Douglas taught a Java application creates an object (i.e.: a signed object) for communication, wherein the signed object is suitably associated with an object context in accordance with the message and communicated over network or before received by the user [Douglas, col 4 lines 8-36].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the technique of creating a signed object after sent wherein an application program associated with the context of the message before received by the user as taught by Douglas into the Horvitz's apparatus in order to utilize the Java applet characteristics.

Doing so would improve the method for filtering and adapting the content of email message.

6. Claim 2 Horvitz discloses the electronic message is opened by the user by clicking on an identifier of the electronic message in an electronic mail browser [Horvitz, view this message, col 8 line 5].

7. Claim 5 Horvitz discloses the execution of the application program includes a functionality based on a text included with the electronic message [Horvitz, execute the applet, col 8 line 66].
8. Claim 6 Horvitz discloses the execution of the application program includes the display of streaming video over the network [Horvitz, video feed, col 22 line 2].
9. Claim 7 Horvitz discloses the execution of the application program includes outputting an advertisement as inherent feature of email message.
10. Claim 8 Horvitz discloses the application program is executed on a network browser as inherent feature of Internet and client email program [Fig 1].
11. Claim 11 Horvitz discloses the execution of the application program includes the ability to send a new electronic message over the network as inherent feature of Internet and client email program [Fig 1].
12. Claim 12 Horvitz discloses the execution of the application program produces at least one of a pictorial, graphic, animated, video and audio display as inherent feature of Java or application program.
13. Claim 13 Horvitz discloses the application program includes markup language which calls an object-oriented computer language as design choice.
14. Claim 15 Horvitz discloses A computer program embodied on a computer readable medium for executing an application program associated with an electronic message, comprising:

a segment at least partially within an electronic message for initializing at least one

application program by automatically retrieving code from a server over a network after the electronic message is received over a the network and is opened for viewing by a user, wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message [Horvitz, execute client email program or application program, download from an email server, a preview mode is selected, open this message, col 7 lines 40-col 8 line 6; execute client email program or application program, download from an email server, a preview mode is selected, open this message, col 7 lines 40-col 8 line 6], and
a code segment automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof [Horvitz, automatic execution of a software or application program, applet, col 21 lines 21-58].

However, Horvitz does not explicitly detail

wherein the application program becomes associated with a context of the electronic message after being sent but before being received by the user;

Douglas taught a Java application creates an object (i.e.: a signed object) for communication, wherein the signed object is suitably associated with an object context in accordance with the message and communicated over network or before received by the user [Douglas, col 4 lines 8-36].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the technique of creating a signed object after sent

wherein an application program associated with the context of the message before received by the user as taught by Douglas into the Horvitz's apparatus in order to utilize the Java applet characteristics.

Doing so would improve the method for filtering and adapting the content of email message.

15. Claim 19 Horvitz discloses A computer program embodied on a computer readable medium for executing an application program associated with an electronic message as recited in claim 15 wherein at least one code segment resides, at least in part, in a browser software [Horvitz, client email program, Fig 1].

16. Claim 16 Horvitz discloses An electronic message (?) comprising:
a data object including text that had been received over a network and stored in a computer readable medium on a computer having an electronic mail program; and
an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and opening for viewing of the data object, the application program object being stored in a computer readable medium automatically executed on the computer after the initialization thereof message [Horvitz, execute client email program or application program, download from an email server, a preview mode is selected, open this message, col 7 lines 40-col 8 line 6;
execute client email program or application program, download from an email server, a

preview mode is selected, open this message, col 7 lines 40-col 8 line 6; automatic execution of a software or application program, applet, col 21 lines 21-58],

However, Horvitz does not explicitly detail wherein the application program becomes associated with a context of the electronic message after being sent but before being received by the user;

Douglas taught a Java application creates an object (i.e.: a signed object) for communication, wherein the signed object is suitably associated with an object context in accordance with the message and communicated over network or before received by the user [Douglas, col 4 lines 8-36].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the technique of creating a signed object after sent wherein an application program associated with the context of the message before received by the user as taught by Douglas into the Horvitz's apparatus in order to utilize the Java applet characteristics.

Doing so would improve the method for filtering and adapting the content of email message.

17. Claim 17 Horvitz discloses the application program object develops at least one of a pictorial, graphic, animated, video and audio display [Horvitz, video feed, col 22 line 2].

18. Claim 18 Horvitz discloses the at least one of the pictorial, graphic, animated, video and audio display is streamed to the application program over the network [Horvitz, video feed, col 22 line 2].

Claim Rejections - 35 USC § 103

Claims 3,14,20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al [Horvitz 6,161,130] in view of Dennis [6,651,087 B1]

19. Claim 20 Horvitz discloses A computer program embodied on a computer readable medium for executing an application program associated with an electronic message

Horvitz taught java applet and client email program. However Horvitz does not explicitly detail

wherein the browser software includes the functionality of running a Java applet.

In the same endeavor, Dennis taught an email program and a browser program [Dennis, col 4 lines 35-50] an email with attachment file containing an execution instructions such as java script [Dennis, col 8 lines 27-38; col 10 lines 1-45]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the technique of attaching an application program or an java applet/script as taught by Dennis into the Horvitz's apparatus in order to utilize the email service process.

Doing so would improve the method for accessing an attachment file and enhancing the email process.

20. Claim 21 Horvitz discloses A computer program embodied on a computer readable medium for executing an application program associated with an electronic message wherein the application program develops at least one of a pictorial, graphic, animated, video and audio display [Horvitz, video feed, col 22 line 2].

21. Claim 22 Horvitz discloses A computer program embodied on a computer readable medium for executing an application program associated with an electronic message wherein the at least one of the pictorial, graphic, animated, video and audio display is streamed to the application program over the network [Horvitz, video feed, col 22 line 2].

22. Claim 3 Horvitz discloses the application program includes an applet [Horvitz, applet, col 10 line 66].

23. Claim 14 Horvitz discloses the object-oriented computer language includes an applet [Horvitz, applet, col 10 line 66].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong H. Vu whose telephone number is 571-272-3904. The examiner can normally be reached on 6:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on 571-272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong H Vu/
Primary Examiner, Art Unit 2419